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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/997,588

11/29/2001

Chen Xing Su

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21999

7590

06/29/2005

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EXAMINER

LEITH, PATRICIA A

ART UNIT

PAPER NUMBER

1655

DATE MAILED: 06/29/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/997,588

Applicant(s)

SU ET AL.

Examiner

Patricia Leith

Art Unit

1654

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 February 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 4-28 is/are pending in the application.
- 4a) Of the above claim(s) 13-23, 27 and 28 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 4-12 and 24-26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claims 1 and 4-28 are pending in the application.

Claims 13-23 were withdrawn from further consideration on the merits as being drawn to a non-elected invention per the election without traverse in the Office Action dated 6/18/03. Claims 27 and 28 were also withdrawn from consideration as being drawn to a non-elected invention due to election by original presentation in the Office Action dated 2/11/03.

Claims 1 , 4-12 and 24-26 were examined on their merits.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a previous Office Action.

Claim Rejections - 35 USC § 103

Claims 1, 4-12 and 24-26 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Mumford (1998) in view of Brock et al. (1991), in view of Gagnon (1997) in view of Nahir (EP 0 555 573 A1) and further in view of the Associated Press, Buffalo News (11/1996).

Applicant's arguments were fully considered, but not found persuasive.

Applicant has amended claim 1 to require pulp in the composition.

Applicant argues: Mumford neither discloses nor suggests consuming Morinda citrifolia fruit juice to inhibit, prevent or reverse lipid peroxidation (p. 10, Arguments). It is deemed that this would be an intrinsic property of Morinda citrifolia juice, since all mammals have lipid peroxidation and would manifest any time someone ingested the fruit; similarly, the only step in Applicant's method is consumption of the juice.

Applicant argues that "...no cited reference teaches administering Morinda citrifolia juice in combination with processed Morinda citrifolia pulp....Mumford taught the administration of juice alone....Mumford teaches away from combining Morinda citrifolia juice with either the pulp or a second juice". The Examiner respectfully disagrees. It is well known in the art that juice is sold with and without pulp. It is not a *priori* known if the Morinda citrifolia juice reported by Mumford contained pulp. However, it is deemed that the addition or removal of pulp from the juice would have merely been a matter of design choice. One of ordinary skill in the art would have been motivated to leave the pulp in the juice, in order to attract consumers who prefer pulp in their juice. There is also no indication in the Instant specification that Morinda citrifolia juice with

pulp or Morinda citrifolia juice without pulp makes any measurable difference with regard to inhibiting lipid peroxidation.

Applicant argues that "Buffalo News does not teach combining soy protein powder with orange juice because it tastes terrible. Rather Buffalo News teaches mixing a dried powder with a liquid... so the dried powder could be ingested" (p. 11, Arguments). However, this reference makes it clear that it is common in the art to use juices as carriers for natural medicines. It is also pointed out that a rejection under 35 U.S.C. ' 103 based upon the combination of references is not deficient solely because the references are combined based upon a reason or technical consideration which is different from that which resulted in the claimed invention. Ex parte Raychem Corp, 17 U.S.P.Q. 2d 1417. Thus, although Buffalo News did not specifically teach that the soy powder was not palatable, it is deemed that the addition of orange juice made the soy powder taste better. The rationale to modify or combine the prior art does not have to be expressly stated in the prior art; the rationale may be expressly or impliedly contained in the prior art or it may be reasoned from knowledge generally available to one of ordinary skill in the art, established scientific principles, or legal precedent established by prior case law. In re Fine, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); In re Jones, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). See also In re Kotzab, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000) (setting forth test for implicit teachings); In re Eli Lilly & Co., 902 F.2d 943, 14 USPQ2d 1741 (Fed. Cir. 1990) (discussion of reliance on legal precedent); In re Nilssen, 851 F.2d 1401,

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1403, 7 USPQ2d 1500, 1502 (Fed. Cir. 1988) (references do not have to explicitly suggest combining teachings); Ex parte Clapp, 227 USPQ 972 (Bd. Pat. App. & Inter. 1985) (examiner must present convincing line of reasoning supporting rejection); and Ex parte Levengood, 28 USPQ2d 1300 (Bd. Pat. App. & Inter. 1993) (reliance on logic and sound scientific reasoning).

It is deemed that the ordinary artisan, knowing that Morinda citrifolia juice 'tastes awful', and that natural medicines are combined with juices such as orange juice which is palatable, that Morinda citrifolia juice would have been advantageously combined with a juice such as orange juice in order to create a more palatable juice.

From the teachings of the references, it is apparent that one of ordinary skill in the art would have had a reasonable expectation of success in producing the claimed invention. Therefore, the invention as a whole was *prima facie* obvious to one of ordinary skill in the art at the time the invention was made, as evidenced by the references, especially in the absence of evidence to the contrary.

No Claims are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Patricia Leith whose telephone number is (571) 272-0968. The examiner can normally be reached on 8:30am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bruce Campell can be reached on (571) 272-0974. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Patricia Leith
Primary Examiner
Art Unit 1654

A handwritten signature in black ink, appearing to read 'Patricia Leith', written in a cursive style.

6/27/05